REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 1, 12, 28 and 29 have been amended, and claims 11 and 21 have been cancelled without prejudice or disclaimer. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-10, 12-20, and 28-29 are pending. Claims 22-24 and 26 are withdrawn. Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at pages 2-6, numbered paragraphs 3-21, claims 1-21 and 28-29 were rejected under 35 U.S.C. §103 as being unpatentable over Oohchida et al. (USPN 6,584,060; hereafter, Oohchida) in view of Inada et al. (JPO Patent Application JP 60-257584; hereafter, Inada). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

It is respectfully submitted that the present claimed invention, as set forth in independent claims 1, 12, 28 and 29, discloses two different photodetectors, a monitoring photodetector and a signal detecting photodetector. As recited in paragraph [0034] of the specification, "A portion of light emitted from the light source 10 travels toward a disc 25 after passing through the effective aperture of the grating 13, and the remainder of the light is reflected from the reflecting member 15 and incident on the monitoring photodetector 12. Power of recording light for recording information on the disc 25 is controlled using a signal detected by the monitoring photodetector 12." (emphasis added)

As recited in paragraphs [0038]-[0039], recited below for the convenience of the Examiner, focusing servo and tracking servo operations are performed using a light signal focused on a signal detecting photodetector:

> [0038] Light passed through the grating 13 is reflected from the optical path changer 17, passes through the collimating lens 20 and the objective lens 23, and is condensed on the disc 25 so that information is recorded on the disc 25. Next, light reflected from the disc 25 passes through the objective lens 23, the collimating lens 20, and the optical path changer 17, and is focused on a signal detecting photodetector 30. (emphasis added)
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> [0039] Focusing servo and tracking servo operations are performed using a light signal focused on a signal detecting photodetector 30. At this time, even if a portion of the light incident on the signal detecting photodetector 30 is reflected, the reflected light is not incident on the monitoring photodetector 11. (emphasis added)

Hence, the signal detecting photodetector of the present invention does not enable the monitoring photodetector to accurately determine a power of recording light, but instead receives light reflected from the disc and utilizes said light for focusing servo and tracking servo operations. Thus, the signal detecting photodetector of the present invention does not control the monitoring photodetector, as would be the case if Oohchida and Inada were to be combined. Hence, the combination of Oohchida and Inada teaches away from the present claimed invention.

As recited in claim 1, the present claimed invention utilizes two separate photodetectors that have separate functions, and which utilize light reflected from the reflecting member to determine power of recording light and to receive light reflected from the disc, respectively. In contrast, Oohchida recites a single photodetector unit for detecting the diffracted returning light beam that is reflected by the reflective optical surface. Inada recites a photodetector for keeping a light output at a specific level, wherein a semiconductor laser with a built-in photodetector eliminates a problem that the ratio of the front surface light and the back surface light changes when the light coming out of from a resonance surface is partially returned to the resonator so that the output from the front surface light cannot be controlled by the back surface light.

On page 3 of the Office Action, the Examiner submits: "One of ordinary skill in the art at the time of the invention would have realized that the system of Oohchida would have been sensitive to noise when monitoring the reflected light from the disc and ratio of reflected light to original light will be different and some mechanism to reduce this noise could be necessary to improve the quality of the signal" (emphasis added). It is respectfully submitted that there is no teaching or suggestion that a ratio of reflected light to original light will be different so that combination of Oohchida with Inada is needed. Nowhere does Oohchida suggest that the system of Oohchida would be sensitive to noise to that some mechanism to reduce this noise could be necessary. It is also respectfully submitted that Inada (published December 19, 1985) was known to those skilled in the art at the time Oohchida was filed (June 24, 1999) and when the foreign priority document of Oohchida was filed (June 24, 2998). Inada does not teach or suggest combination with Oohchida, which had not yet been filed when Inada was published. Oohchida does not teach or suggest combination of the elements of Inada with Oohchida. The Examiner simply states that it would be obvious to combine Oohchida and Inada. Such a statement does not represent motivation or suggestion. Had it been obvious to one skilled in the art to combine Oohchida with Inada at the time Oohchida was filed, Oohchida would have done so. There is no indication that Oohchida considered such a combination.

It is respectfully submitted that the Examiner is using hindsight to provide a blueprint of

the present invention. In Ruiz and Foundation v. A.B. Chance Company, 69 USPQ2d 1690 (CAFC January 29, 2004), the court held:

> In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.
> Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See In re Rouffet, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

It is respectfully submitted that the Examiner is providing no motivation or suggestion of combining Oohchida and Inada to obtain the present claimed invention.

However, in order to further prosecution of the present application, independent claim 1 has been amended to include the features of claim 11. Claim 11 has been canceled without prejudice or disclaimer. In addition, for clarity, claim 1 has been amended to recite: "An optical pickup light condensing recording system, ..." Also, claim 1 has been amended to state more clearly that the signal detecting photodetector receives the condensed light reflected from the disc, as is apparent from the terminology of claim 1 which states: "an objective lens which condenses the light the optical path of which is changed onto a disc."

Independent claim 12 has been amended to include the features of claim 21. Claim 21 has been canceled without prejudice or disclaimer. . In addition, for clarity, claim 12 has been amended to recite: "An optical pickup light condensing recording system, ..." Also, claim 12 has been amended to state more clearly that the signal detecting photodetector receives the condensed light reflected from the disc, as is apparent from the terminology of the preamble of claim 12 which states: "in which a portion of light emitted from a light source is condensed onto a disc."

Independent claims 28 and 29 have been amended in similar fashion as independent claims 1 and 12.

It is respectfully submitted that the Examiner admits: "Oohchida does not specifically disclose that this monitoring unit is separate from main monitoring diode and it does not monitor

reflecting light to the extent claimed." Inada teaches a semiconductor laser that balances the ratio of the front surface light and the back surface light by outputting front surface light emitted at +/- 30° and reflecting the remaining light to the inside by the reflection film coated on the window glass, wherein the reflected light is utilized to stabilize the front surface light output.. Inada does not teach or suggest condensing light, but rather simply redirects light by reflection.

In contrast, amended independent claim 1 of the present invention, and similarly, amended independent claims 12, 28 and 29, recites an optical pickup light condensing recording system wherein an objective lens condenses light to provide a condensed incident beam on the disc (see FIGs. 3 and 4 of the present invention, for example). In addition, amended independent claim 1, and similarly, amended independent claims 12, 28, and 29 set forth that the condensed light beam is reflected from the disc and fed back to the signal detecting photodetector so that the signal detecting photodetector outputs a light signal output based at least partially on light reflected from the disc, wherein the light signal drives focusing servo and tracking servo operations, which is not taught or suggested by Inada.

Hence, the combination of Oohchida and Inada teaches away from the present claimed invention.

Thus, it is respectfully submitted that amended independent claims 1, 12, 28 and 29 are patentable under 35 U.S.C. §103 over Oohchida et al. (USPN 6,584,060) in view of Inada et al. (JPO Patent Application JP 60-257584). Since claims 2-10 and 13-20 depend from claims 1 and 12, respectively, claims 2-10 and 13-20 are patentable under 35 U.S.C. §103 over Oohchida et al. (USPN 6,584,060) in view of Inada et al. (JPO Patent Application JP 60-257584) for at least the reasons claims 1 and 12 are patentable under 35 U.S.C. §103 over Oohchida et al. (USPN 6,584,060) in view of Inada et al. (JPO Patent Application JP 60-257584).

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: March 19, 2007 By: Darleen J. Stockley

Darleen J. Stockley
Registration No. 34,257

1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501